

REMARKS

At the time of the First Office Action dated August 26, 2008, claims 1, 8, and 15 were pending and rejected in this application.

CLAIMS 1, 8, AND 15 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON WILLIAMS ET AL., U.S. PATENT PUBLICATION NO. 2003/0212561 (HEREINAFTER WILLIAMS) IN VIEW OF KOEHLER ET AL., U.S. PATENT PUBLICATION NO. 2003/0156706 (HEREINAFTER KOEHLER)

On pages 2-4 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been impelled to modify Williams in view of the Koehler to arrive at the claimed invention. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103." Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Upon viewing the Examiner's analysis, the Examiner appears to be employing rationale (G). If the Examiner maintains the present rejection or if the Examiner presents a different rejection under 35 U.S.C. § 103, and the Examiner is not relying upon rationale (G), Applicants request that the Examiner clearly identify the rationale, as described in the Examination Guidelines, being employed by the Examiner in rejecting the claims under 35 U.S.C. § 103.

Referring again to rationale (G), as discussed on page 57,534 of the Examination Guidelines, the following findings of fact must be articulated by the Examiner:

- (1) a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- (2) a finding that there was reasonable expectation of success; and
- (3) whatever additional findings based on the Graham factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Upon reviewing the Examiner's analysis in view of the requirements discussed above necessary for the Examiner to establish a prima facie case of obviousness, Applicants recognize

1 several deficiencies in the Examiner's analysis. At the outset, Applicants note that the Examiner has
2 failed to set forth claim constructions for the claimed limitations. For example, claim 1 recites
3 "simulating a text equivalent and an execution time for each of the nominal output and the pre-
4 determined user input." However, the Examiner has failed to set forth a claim construction for
5 either "simulating a text equivalent" or "simulating ... an execution time for each of the nominal
6 output and the pre-determined user input."

7
8 The Examiner has also failed to properly characterize the scope and content of the prior
9 art. For example, on page 2 of the First Office Action, the Examiner relies upon Williams to
10 teach "processing the user simulation script ([0034]) to generate both a simulated output for the
11 voice application corresponding to the nominal output and a simulated input for the voice
12 application corresponding to a pre-determined user input ([0048]) to the voice application.
13 However, on page 3 of the First Office Action, the Examiner asserts "Williams fails to teach
14 generating both simulated output for the voice application corresponding to the nominal output
15 and a simulated input deriving from the voice application a nominal output of the voice
16 application." These statements appear to be contradictory. As such, the Examiner has failed to
17 clearly characterize the scope and content of the prior art.

18
19 Moreover, Applicants disagree that the Examiner's assertion that paragraphs [0049] and
20 [0053] teach "simulating a text equivalent and an execution time for each of the nominal output
21 and the pre-determined user input." Paragraphs [0049] and [0053] are both silent as to teaching a
22 *simulated execution time* for each of the nominal output and the pre-determined user input.
23 Thus, the Examiner has mischaracterized the scope and content of Williams.

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2 In the paragraph spanning pages 3 and 4 and in the first full paragraph on page 4 of the First
3 Office Action, the Examiner characterized the teachings of Koehler. However, Applicants are
4 unclear as to the precise relevancy of these teachings. Koehler is directed to a training tool for
5 training call center agents based on verbal and/or interaction with simulated customers in dynamic
6 scenarios. On the contrary, the teachings of both the claimed invention and Williams are directed to
7 a testing system that removes human interaction. In this regard, Applicants respectfully submit that
8 Koehler is non-analogous prior art that cannot be properly applied against the claimed invention.
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10 Whether a prior art reference is from a nonanalogous art involves (a) determining
11 whether the reference is within the same field of endeavor and (b) determining whether the
12 reference is reasonably pertinent to a known problem in the art. In re Clay, 23 USPQ2d 1058
13 (Fed Cir. 1992). If the prior art is outside the inventor's field of endeavor, the inventor will only
14 be presumed to have knowledge of prior art that is reasonably pertinent to a known need or
15 problem in the field of endeavor. KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82
16 USPQ2d 1385, 1397 (2007). The Examiner is also charged to consider "'the reality of the
17 circumstances' ... in other words, common sense" to determine what field a person of ordinary
18 skill in the art would reasonably be expected to look. In re Oetiker, 977 F.2d 1443, 24 USPQ2d
19 1443 (Fed. Cir. 1992).
20

21 As already noted above, Koehler is not with the same field of endeavor as either the claimed
22 invention or Williams. Moreover, the Examiner has failed to identify whether Koehler is
23 reasonably pertinent to a known need or problem in the field of endeavor. For example, the

1 "progress report" identified by the Examiner in the first full paragraph on page 4 of the First Office
2 Action is related to the human trainee. However, since human trainees are not part of the field of
3 endeavor (i.e., automated device for test voice applications), the addition of a progress report does
4 not solve any known need or problem in the field of endeavor.

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6 Yet another omission in the Examiner's analysis is the omission of a finding of fact, as
7 required by rationale (G), of a reasonable expectation of success. Again, Koehler involves human
8 interaction and is used to train the human. On the other hand, Williams is used to test a voice
9 application and does not involve human interaction. Appellants are unclear as to how one having
10 ordinary skill in the art would enjoy a reasonable expectation of success in combining the
11 applied prior art when these applications are directed to different systems having different inputs,
12 different outputs, and different purposes.

13
14 Applicants, therefore, respectfully submit that the imposed rejection of claims 1, 8, and
15 15 under 35 U.S.C. § 103 for obviousness based upon Williams in view of Koehler is not viable,
16 and hence, Applicants solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 26, 2008

Respectfully submitted,

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